

REMARKS

This paper is supplemental to the prior papers submitted in response to the Office Action mailed on April 8, 2004, and takes into account the points made by Examiner Omgba during the interview of February 24, 2005.

Prior to this paper, claims 1-13 were pending. By this paper, Applicant does not cancel any claims, and amends claims 1, 3, 9 and 13. Therefore, claims 1-13 remain pending.

Applicant respectfully submits that the present application is in condition for allowance for the reasons that follow.

Indication of Allowable Subject Matter

Applicant again thanks Examiner Omgba for the indication that claims 4-6, 8 and 10 are allowable.

In-Person Interview of February 24, 2005

Applicant thanks Examiner Omgba for extend the courtesy of an in-person interview on February 24, 2005, where it was agreed that claim 1, as amended prior to this paper, overcomes the Bazydola reference.

Possible Rejections Under 35 U.S.C. § 103

During the interview of February 24, 2005, Examiner Omgba indicated that the amendments of October 07, 2004, to claims 1, 2 and 9 overcame the rejection of these claims under 35 U.S.C. §102 as being anticipated by Applicant's Admitted Prior Art (AAPA), but that he would likely reject the claims under 35 U.S.C. §103 as being obvious in view of the AAPA.

Because of the possibility that a future obviousness rejection might be made, in order to advance prosecution, and without prejudice or disclaimer, Applicant has further amended claims 1, 9 and 13, as seen above, to positively recite that the seating detection element is “**adapted to be moved with said work and movable relative to** said work seating surface” to detect a seating of said work on said work seating surface. (Emphasis added.)

In contrast, no component of the detector of the AAPA is adapted to be (i) moved with a work and (ii) also move relative to a work seating surface to detect the seating of the work on the surface. The AAPA teaches a detector that, at most detects the work at a distance. That is, the detector of the AAPA does not include an element that may move with the work as the work is positioned onto the seating surface, the movement being relative to the seating surface. Thus, the detector of the AAPA may indicate that a work is seated on the work surface when in fact the work is still traveling towards the work surface, as opposed to the present invention, which may be used to definitively determine that work is seated on the work surface.

* * * * *

The Interview Summary of February 24, 2005, states that “using a movable detection element or a sensor as taught in the prior art as discussed in the background section of the specification is an obvious matter of *design choice*.” Applicant respectfully submits that reliance on “design choice” is only appropriate (if at all) when the difference between the prior art and the claims of the present invention amounts only to “Reversal, Duplication, or Rearrangement of Parts.” (See MPEP § 2144.04(VI), the only portion of MPEP § 2100 that mentions “design choice.”) The difference between the cited references and the present invention is more than just the reversal, duplication, or rearrangement of parts. Indeed, to arrive at the present invention, the AAPA must be modified to include, among other things, a moveable detection element, a feature not taught in the AAPA. Thus, design choice cannot be relied on for motivation to modify the AAPA. That is, even prior to the above proffered amendments to the claims, the claims are allowable in view of the AAPA.

* * * * *

MPEP § 2143.01 details the requirements on the PTO for establishing motivation to modify or combine references to reject a claim as obvious under 35 U.S.C. §103. One requirement, as detailed in MPEP § 2143.01, subsection 6, is that “the proposed modification cannot change the principle of operation of a reference – If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).” In *Ratti*, the CCPA held that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference.” This substantial redesign would have resulted in changing a rigid seal to a resilient seal. Thus, a reference cannot be modified to render an invention obvious if the modification changes a principle of operation of the reference.

With the above in mind, it is respectfully submitted that since the teachings of the AAPA rely on the principle of using a non-moving proximity sensor to detect the work, substituting a detection element that moves with a work and relative to a work seating surface for the non-moving proximity sensor of the AAPA would change the principle of operation of the AAPA. Since modifying the AAPA to utilize a moving element changes the principle of operation of the AAPA, just as changing the rigid seal to a resilient seal was found to change the principle of operation in *Ratti*, “the teachings of [the AAPA] are not sufficient to render the claims *prima facie* obvious.” (MPEP § 2143.01, emphasis added.)

* * * * *

In sum, claims 1, 2, 9, 11 and 13 are allowable in view of the deficiencies of the AAPA.

* * * * *

In regard to Bazydola (U.S. Patent No. 5,970,612), it was agreed during the interview of February 24, 2005, that the amendments made in October 07, 2004, overcome the Bazydola reference. Thus, the claims rejected solely in view of Bazydola, have been placed into independent form, as seen above, and Applicant respectfully submits that these claims are now in condition for allowance. Therefore, claims 3, 7 and 12 are allowable.

Conclusion

Applicant believes that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Omgba is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Date May 03, 2005

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4747
Facsimile: (202) 672-5399

Respectfully submitted,

By

Martin J. Cosenza
Attorney for Applicant
Registration No. 48,892